

REMARKS

Thorough examination of the application is sincerely appreciated.

Applicant's claims were amended to remove European-type phraseology and address various formalities, as well as clarify and particularly point out the patentable subject matter of the present invention.

Applicant re-introduces claims 16-18, which were inadvertently canceled, as new claims 25-27. Applicant regrets any inconvenience to the examiner.

According to the Office Action, claim 19 was objected to due to an incorrect dependency. In response, claim 19 is amended to correct its dependency. Withdrawal of the objection is respectfully requested.

Further according to the Office Action, claims 1-3, 6, 10, 12-15, 19 and 20 were rejected under 35 USC 103(a) as being obvious over US Published Application US 2002/0009061 (hereinafter "Willenegger") in view of US Patent 6,603,752 (hereinafter "Saifuddin"). Further according to the Office Action, claims 4, 5, 7 and 11 were rejected under 35 USC 103(a) as being obvious over Willenegger in view Saifuddin and further in view of US Patent 6,862,449 (hereinafter "Mohebbi"). Still further according to the Office Action, claims 8 and 9 were rejected under 35 USC 103(a) as being obvious over Willenegger in view Saifuddin and further in view of US Patent 6,385,462 (hereinafter "Baum"). In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

Referring to page 4 of the Office Action, the examiner points to Willenegger for the alleged disclosure of Applicant's feature of "a radio communication system having physical control channels arranged for the bi-directional transmission of sets of control information

between a secondary station and a plurality of primary stations,” as recited in claim 1.

Applicant’s representative has carefully reviewed the Willenegger patent and failed to find such a disclosure in the patent, contrary to the examiner’s remarks.

It is respectfully submitted that the examiner is factually wrong in relying on Willenegger. The examiner indicates that in Willenegger “Sections 0037, 0049 lines 1-6, CDMA systems have forward and reverse DPCHs thus there will be bi-directional transmissions of sets of control information.” Applicant respectfully disagrees, as Willenegger is completely silent on the bi-directional transmission of sets of control information between a secondary station and a plurality of primary stations. Willenegger discloses the following in Sections [0037] and [0049] relied upon in the Office Action:

“[0037] The downlink DPCH is used to transmit user-dedicated data in a time-division multiplexed manner with control data (e.g., pilot, power control information, and so on). The downlink DPCH may thus be viewed as a multiplex of a downlink dedicated physical data channel (DPDCH) and a downlink dedicated physical control channel (DPCCH).

[0049] If the downlink DPCH is in soft handoff, the user terminal collects and combines the transmit power from a set of base stations to recover the transmission on the DPCH. The power control for the DPCH is then based on the total power for the DPCH received from all transmitting base stations ...”

It is not clear as to how the Willenegger’s disclosure, exemplified in the above paragraphs, is related to Applicant’s feature of the bi-directional transmission of sets of control information between a secondary station and a plurality of primary stations. Nowhere in his patent does Willenegger show or teach, among other things, Applicant’s feature, as recited in Applicant’s claim 1. Willenegger merely teaches the user terminal (mobile station) collecting and combining the transmit power from base stations on the downlink physical channel. Clearly, Willenegger is

completely silent on the bi-directional transmissions of sets of control information (uplink and downlink), as recited in Applicant's claim 1. Since there is no disclosure on the bi-directional control in the patent, it follows that Willenegger fails to teach or suggest Applicant's feature of "respective closed-loop power control means ... for individually adjusting the power of some or all physical control channels," as recited in claim 1.

If the examiner still disagrees and believes otherwise, he is respectfully requested 1) to specifically point out where such a disclosure can be found in Willenegger; 2) to provide an affidavit stating facts within his personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Willenegger can't be supported by the record.

Furthermore, it is unclear whether the examiner relied on personal knowledge of the facts or those of a skilled artisan in his statement of "inherent capability" on page 4 of the Office Action. If this is the case, then "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 1371. The MPEP provides guidelines for relying on official notice and personal knowledge, which the Examiner did not follow in this case:

The rationale supporting an obviousness rejection may be based on common knowledge in the art of "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art ...

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. If the rejection is maintained, it is respectfully requested that the examiner provide an affidavit stating facts within his personal knowledge or an affidavit by a skilled artisan.

It is respectfully submitted that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Analyzing the references according to the above roadmap, first the examiner did not offer any motivation or suggestion to modify or combine Willenegger and Saifuddin except for the unsupported, conclusory remark that "it would have been obvious ... to modify the system of Willenegger with the gating method and circuitry of Saifuddin for the purpose of providing optimum battery savings as taught by Saifuddin." It is not clear what the basis was for such a statement and how it related to Applicant's features. In contrast to the remarks in the Office Action, Willenegger is directed to "techniques for controlling transmit power of multiple channels in a CDMA communication system," and Saifuddin is directed to "the present invention describ[ing] a method and apparatus which identifies closed loop power control commands that have been generated erroneously based on portions of a frame that have been gated ... the identified power control commands are ignored." It is not clear as to how Willenegger's

downlink power control scheme can be reconciled with Saifuddin's erroneously generated power control command, which are ignored. There is absolutely no motivation or suggestion to combine the references as the concepts used in the two patents are not compatible.

Second, there is no reasonable expectation of success because the prior art references are not combinable. Not only do the references fail to supplement each other, but Saifuddin's teaching is directly contrary to Willenegger.

Third, Willenegger and Saifuddin, even when combined, do not teach Applicant's feature of "physical control channels arranged for the bi-directional transmission of sets of control information between a secondary station and a plurality of primary stations, wherein respective closed-loop power control means are provided for individually adjusting the power of some or all physical control channels, or parts thereof, to which a set of control information is mapped, said closed-loop power control means being utilized to select a subset of primary stations greater than one primary station, selected from the plurality of primary stations, for the transmission of data over at least one data channel between the selected subset of primary stations and the secondary station," as recited in claim 1 and discussed above. As argued above, the Applicant's features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited references fail to render obvious the claimed invention, because the above-identified criteria are not met. The claimed invention, according to claim 1, is thus distinguishable over the cited references.

Analysis of independent claims 6, 10 and 20 is analogous to the one of claim 1, as presented hereinabove. To avoid repetition, claims 6, 10 and 20 will not be discussed in detail with the understanding that they are patentable at least for the same reasons as claim 1.

Applicant, therefore, respectfully requests withdrawal of the rejection and allowance of claims 6, 10 and 20.

Claims 2, 3, 12-15, 19 and 25-27 depend from independent claims, which have been shown to be allowable over Willenegger and Saifuddin. Accordingly, claims 2, 3, 12-15, 19 and 25-27 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 2, 3, 12-15, 19 and 25-27 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

Claims 4, 5, 7-9 and 11 depend from independent claims, which have been shown to be allowable over the prior art references. Mohebbi and Baum are not relied upon in the Office Action to teach or suggest Applicant's features in independent claims. Hence, Mohebbi and Baum do not cure the deficiencies in Willenegger and Saifuddin. Accordingly, claims 4, 5, 7-9 and 11 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 4, 5, 7-9 and 11 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

In view of the above, it is respectfully submitted that Willenegger, Saifuddin, Mohebbi and Baum, whether alone or in combination, do not anticipate or render obvious the present invention.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in

condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

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